

## REMARKS

Claims 1, 3-18, 20-21 and 23-34 are pending in the present application. Claims 1, 18 and 27 are currently amended. Claims 2, 19, 22 and 35 are cancelled. Claims 1, 15, 18, 27, 30, 33 and 34 are in independent form. Claims 3-14, 16-17, 20-21, 23-26, 28-29 and 31-32 depend from independent claims 1, 15, 18, 18, 27 and 30, respectively. In the aforementioned *Office Action*, claims 1, 3-18, 20-21 and 23-34 were examined and rejected. In view of the following amendment and remarks, Applicants respectfully request reconsideration of the application.

### *Information Disclosure Statement*

Applicants have submitted, herewith, an Information Disclosure Statement (IDS) compliant with 37 C.F.R. § 1.97.

The Examiner noted documents cited in the IDS of Jan 21, 2000 that were not received for consideration. *Office Action*, 2, ¶ 6. The Applicants herein submit a replacement IDS with all cited documents. Consideration of the present IDS is respectfully requested.

### *Rejections under 35 U.S.C. § 101*

The Examiner rejected claims 1, 15, 18, 27, 30 and 33-34 under 35 U.S.C. § 101, "because the claimed invention is directed to non-statutory subject matter." *Office Action*, 4, ¶ 7. The Examiner rejected claims 3-14, 16-17, 20-21, 23-26, 28-29 and 31-32, depending from independent claims 1, 15, 18, 18, 27 and 30 respectively, on the same basis. Applicants respectfully traverse the Examiner's 35 U.S.C. § 101 rejection in that the invention is directed to statutory subject matter.

35 U.S.C. 101 requires that a claimed invention, as a whole, be useful and accomplish a practical application; that is, it must produce a “useful, concrete and tangible result.” State Street Bank & Trust Co. v. Signature Financial Group, 149 F.3d 1368, 1373–74 (Fed. Cir. 1998). The purpose of this requirement is to limit patent protection to inventions that possess a certain level of ‘real world’ value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research. See In re Fisher, 421 F.3d 1365 (Fed. Cir. 2005).

Applicants contend the independent claims all possess a certain level of ‘real world’ value in that they all teach a ‘useful, concrete and tangible result,’ because they all have some means to communicate a recommendation to a user, e.g., ‘providing the user with recommended information’ as in the case of claim 1. That recommendation itself is useful to someone who values the information provided and a recommendation based on a user’s past decisions or surveys may provide valuable information. Furthermore, the email communication is concrete and tangible. Each of the independent claims recites such claim elements, those elements evidencing a concrete, tangible, and useful result.

The Examiner refers to the **Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility** [hereinafter *Guidelines*] on “Tangible Results.” *Office Action*, 5, ¶ 7. The *Guidelines* provide a further explanation of what is tangible, stating, it to be “the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted.” Applicants contend that recommendations and emails are both tangible and provide a beneficial result (recommendation).

Notwithstanding the tangible utility of the presently claimed invention, the Applicants respectfully contend the Examiner has not adequately provided support to justify a claim rejection under 35 U.S.C. § 101. To support a § 101

rejection, the Examiner must (A) make a *prima facie* showing that the claimed invention lacks utility and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the *prima facie* showing. See In re Gaubert, 524 F.2d 1222, 1224 (CCPA 1975). Therefore, the Applicants respectfully request the Examiner show *why* an email and a list of recommendations (exemplary utilities of the claimed invention) lack specific and substantial utility. See MPEP 2107.02 (requiring any rejection based on lack of utility should include a detailed explanation why the claimed invention has no specific and substantial credible utility).

Applicants respectfully contend the Examiner has not developed a proper *prima facie* case by providing evidentiary support for a rejection under 35 U.S.C. § 101. Emails are used in the *real world* and are useful. Additionally, recommendations delivered via email are useful to the user. As claims 1, 15, 18, 27, 30 and 33–34 provide personalized recommendations through email, these claims are useful, concrete and tangible. As evidentiary support for a rejection under 35 U.S.C. § 101 has not been met, Applicants respectfully request the Examiner's rejection be withdrawn.

#### ***Rejections under 35 U.S.C. § 112, para. 2***

The Examiner rejected claim 27 "under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention." *Office Action*, 6, ¶ 9. As correctly identified by the Examiner, this was a typographical error (i.e., 'fro111' should have been 'from'). The Applicants have adopted the Examiner's assumption and amended claim 27. As such, the Examiner's rejection is moot and withdrawal of the rejection is respectfully requested.

### *Rejections under 35 U.S.C. § 102(e) per Jacobi*

The Examiner rejected claims 1–26 “under 35 U.S.C. § 102(e) as being anticipated by Jacobi et al., [hereinafter *Jacobi*], US Patent No. 6,317,722.” *Office Action*, 7, ¶ 10. Applicants note that claims 2, 19 and 22 have been cancelled. The ‘every element test’ states that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully traverse the Examiner’s 35 U.S.C. § 102(e) rejection, because *Jacobi* does not anticipate claims 1, 3–18, 20–21 and 23–26, because *Jacobi* does not contain each and every element in these claims.

#### **Claim 1**

Claim 1 recites, in part, “**tracking requests** by the user for at least one document on a client document server using the tracking module.” Paragraph 11 of the *Office Action* states that this element is taught by *Jacobi* in col 3, line 43–48; col 7, line 65–67; and col 8, line 1–6. Specifically, *Jacobi* discloses,

For example, if the user currently has three items in his or her shopping cart, these three items can be treated as *the items of known interest* for purposes of generating recommendations, in which case recommendations may be generated and displayed automatically when the user views the shopping cart contents. [col 3, 43–48]

...

As depicted by FIG. 1, the Web server 32 communicates with various *external components* 40 of the site. These external components 40 include, for example, a search engine and associated database (not shown) for enabling users to interactively search the catalog for particular items. Also included within the external components 40 are various order processing modules (not shown) for accepting and processing orders, and for updating the purchase histories of the users. [col 7, line 65–67; col 8, line 1–6].

*Jacobi* discloses what may be identified as an **item of known interest** and various **external components** of the site. *Jacobi* identifies the user's item of known interest by using the current and/or recent contents of the user's shopping cart as inputs to the recommendation service. [See *Jacobi*, col 3, line 39–41]. Neither items nor external components are requests; items are tangible objects and requests are intangible desires. *Jacobi* does **not** disclose the element presently claimed, '**tracking requests** by a user for at least one document on a client document server using a tracking module.'

Claim 1 also recites, in part, "**analyzing the stored information to construct a profile of the user.**" Paragraph 11 of the *Office Action* states that this element is taught by *Jacobi* in col 9, line 41–51. Here, *Jacobi* discloses mapping of a popular item to a corresponding list of similar items. *Jacobi* builds recommendation groupings given unary listings of items that are 'known' to be of interest to users. See *Jacobi*, col 5, line 57–67, col 6, line 1–6. As item groupings are different from users, *Jacobi* does not disclose 'analyzing the stored information to **construct a profile of the user**' as is presently claimed.

As each and every claim element of claim 1 is not taught by *Jacobi*, claim 1 is not anticipated by *Jacobi*. See Verdegaal Bros. Claims 2–14 depend from claim 1. As such these claims are not anticipated for at least the same reasons as claim 1 discussed above. See 35 U.S.C. § 112, para. 4.

### **Claim 15**

Claim 15 recites, in part, "the client document server transmitting, using a computer, the internal content information of the **viewed document** to at least one recommendation software application." Paragraph 24 of the *Office Action* states that this element is taught by *Jacobi* in FIG. 1, col 7, line 34–44. Here, *Jacobi*

discloses the basic components of the Amazon.com Web site, including components used to implement the recommendation service. *Jacobi* teaches that “The ‘items’ that are the subject of the Recommendation Service are the titles (regardless of media format such as hardcover or paperback) that are represented within this database 36.” Also, *Jacobi*, FIG. 1, (the arrows showing the general flow of information that is used by the Recommendation Service, see *Jacobi*, col 7, line 32–34), teaches that the ‘items of known interest’ are transferred to the Recommendation Process. Therefore, *Jacobi* teaches that ‘items of known interest,’ such as a list of titles of books that were dropped into a user’s shopping cart, are transmitted to a recommendation process. *Jacobi* teaches only the transmission of items of interests, not viewed documents. Thus, *Jacobi* does **not** teach ‘transmitting, using a computer, the internal content information of the **viewed document** to at least one recommendation software application’ as is presently claimed.

As each and every claim element of claim 15 is not taught by *Jacobi*, claim 15 is not anticipated by *Jacobi*. See Verdegaal Bros. Claims 16–17 depend from claim 15. As such these claims are not anticipated for at least the same reasons as claim 15 discussed above. See 35 U.S.C. § 112, para. 4.

### **Claim 18**

Claim 18 recites, in part, “determining, using a computer, the **theme and concepts** of the at least one document.” Paragraph 27 of the *Office Action* states that this element is taught by *Jacobi* in col 8, line 7–17. Generally, *Jacobi* discloses that external components also include a shopping cart process which adds and removes items from the users’ personal shopping charts based on the actions of the respective users. Examiner states that, “*Jacobi* specifically teaches users personal shopping cart that processes that personal list, generating, maintaining

user specific items.” *Office Action*, 13, ¶ 27. Here, *Jacobi* teaches the maintenance of a list of items (in a shopping cart). *Jacobi* does **not** teach, however, the presently claimed element, i.e., determining the **theme and concepts** of a document.

Claim 18 also recites, in part, “grouping, using a computer, the at least one documents into at least one **interest folder** according to common themes and concepts.” Paragraph 27 of the *Office Action* states that this element is taught by *Jacobi* in col 8, line 7–17. Generally, *Jacobi* discloses a BookMatcher application in which book titles are given a rating. *Jacobi* teaches rating a title, but does **not** teach, as in the presently claimed element, grouping a document into an **interest folder** according to common themes and concepts.

Claim 18 additionally recites, in part, “**summarizing**, using a computer, the at least one **interest folder** to extract at least **one keyword** representing the common themes and concepts of the interest folder.” Paragraph 27 of the *Office Action* states that this element is taught by *Jacobi* in col 8, line 63–67; and col 9, 1–7. Generally, *Jacobi* discloses a recommendation generation process that can identify items that are of interest to a user. *Jacobi* does **not** teach, however, the presently claimed element, i.e., **summarizing**, using a computer, the at least one **interest folder** to extract at least **one keyword** representing the common themes and concepts of the interest folder.

As each and every claim element of claim 18 is not taught by *Jacobi*, claim 18 is not anticipated by *Jacobi*. See Verdegaal Bros. Claims 20–21 and 23–26 depend from claim 18. As such these claims are not anticipated for at least the same reasons as claim 18 discussed above. See 35 U.S.C. § 112, para. 4.

**Request for withdraw regarding *Jacobi***

As claims 1, 3–18, 20–21 and 23–26 are not anticipated by *Jacobi*, Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 102(e) rejection of claims 1, 3–18, 20–21 and 23–26.

*Rejections under 35 U.S.C. § 102(e) per Adar*

The Examiner rejected claims 27–32 and 34, “under 35 U.S.C. § 102(e) as being anticipated by Adar et al., [hereinafter *Adar*], US Patent No. 6,493,702.” *Office Action*, 16, ¶ 33. Applicants respectfully traverse the Examiner’s 35 U.S.C. § 102(e) rejection, because *Adar* does not anticipate claims 27–32 and 34.

**Claims 27 and 30**

Claims 27 and 30 recite, in part, “**extracting filtered content** from the at least first requested document.” Paragraph 34 of the *Office Action* states that this element is taught by *Adar* in col 6, line 9–19. In this section, *Adar* teaches that users can access bookmarks within a list in several possible ways, such as, clicking on the bookmark or dragging the bookmark. *Adar* continues with teaching that ‘the system logs the event of accessing the bookmark to facilitate tracking frequency and recency of use for all the bookmarks.’ *Adar* does **not** teach, however, ‘**extracting filtered content** from the at least first requested document’ as is presently claimed.

Claims 27 and 30 recite, in part, “**analyzing the filtered content** of the at least first requested document.” Paragraph 34 of the *Office Action* states that this element is taught by *Adar* in col 6, line 42–54. In this section, *Adar* teaches that a newness icon can be used which alerts users that a documents has been updated and popular bookmarks can be flagged with a popularity icon. *Adar* does **not** teach, however, ‘**analyzing the filtered content** of the at least first requested document’ as is presently claimed.



Claims 27 and 30 recite, in part, “providing the user with recommended information **by email** based upon the determined interests of the user.”

Paragraph 34 of the *Office Action* states that this element is taught by *Adar* in col 8, line 10–12; col 12, line 41–47; col 14, line 14–24; and fig 14. *Adar* does not teach this element of claim. *Adar* limits the discussion of emails to be a user **preference**, but does not teach that **recommendations** are sent by email as is presently claimed.

As each and every claim element of claims 27 and 30 are not taught by *Adar*, claims 27 and 30 are not anticipated by *Adar*. See Verdegaal Bros. Claims 28–29 and 31–32 depend from claims 27 and 30, respectively. As such these claims are not anticipated for at least the same reasons as claims 27 and 30. See 35 U.S.C. § 112, para. 4.

#### **Claim 34**

Claim 34 recites, in part, the similar elements of claims 27 and 30 that *Adar* fails to teach. For example, *Adar* does not teach ‘**extract filtered content** from the at least first viewed document,’ ‘**analyze the filtered content** of the at least first viewed document,’ and ‘recommend to the user **by email** the at least second categorized document.’ As such claim 34 is not anticipated for at least the same reasons as claims 27 and 30.

#### **Request for withdraw regarding *Adar***

As claims 27–32 and 34 are not anticipated by *Adar*, Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 102(e) rejection of claims 27–32 and 34.

*Rejections under 35 U.S.C. § 102(e) per Boe*

The Examiner rejected claim 33, “under 35 U.S.C. § 102(e) as being anticipated by Boe et al., [hereinafter *Boe*], US Patent No. 6,236,975.” *Office Action*, 19, ¶ 38. Applicants respectfully traverse the Examiner’s 35 U.S.C. § 102(e) rejection, because *Boe* does not anticipate claim 33.

Claim 33 recites, in part, “a marketing system comprising at least a first computer with at least one **recommendation software application** operable thereon.” Paragraph 39 of the *Office Action* states that this element is taught by *Boe* in Abstract; fig 1; col 3, line 2-6, line 9-12; and col 4, line 31-38. *Boe* teaches a feedback system and the ability to pass information to a business. In *Boe*, the feedback system provides a customer with “feedback showing where he stands relative to his peers.” *Boe*, col 3, line 5–6. As a feedback application is not a recommendation application, because feedback (the return of information about a result or process) is not a recommendation (advice or a suggestion), *Boe* does **not** teach a recommendation software application. Therefore, *Boe* does **not** teach ‘a marketing system comprising at least a first computer with at least one **recommendation software application** operable thereon,’ as is presently claimed.

Claim 33 recites, in part, “wherein the recommendation system is operable to provide a **personalized recommendation package to the user by email** in response to the determined profile.” Paragraph 39 of the *Office Action* states that this element is taught by *Boe* in col 14, line 44–67; and col 15, line 7–7. Although, *Boe* does teach transmitting an email **to the business** to indicate an application has been received, *Boe* does not teach a **personalized recommendation package to the user by email**, as is presently claimed. In *Boe* the email is used to transmit a message to a business, not a user. Also, in *Boe*, the email contains the status

that an application has been received which is not the same as a recommendation package as is in the presently claimed element.

As each and every claim element of claim 33 is not taught by *Adar*, claim 33 is not anticipated by *Adar*. See Verdegaal Bros. As such, Applicants respectfully request the Examiner withdraw the 35 U.S.C. § 102(e) rejection of claim 33.

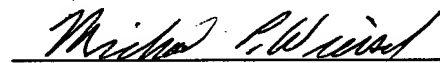
## CONCLUSION

Based on the above amendment and remarks, Applicants believe that the rejections in *the Office Action* of April 21, 2006, are fully overcome, and that the application is in condition for allowance. Applicants respectfully request the passage of the present application to issue. If the Examiner has any questions regarding the present application or other issues that might be expedited through a telephone conference rather than a written action, the Examiner is invited to contact the Applicants' undersigned representative at the number provided below.

Respectfully submitted,  
Oliver et al.

June 21, 2006

By:



Michael P. Wiersch, Reg. No. 55,996  
**Carr & Ferrell LLP**  
2200 Geng Road  
Palo Alto, CA 94303  
Tel: (650) 812-3400  
Fax: (650) 812-3444